

REMARKS

Claims 6, 7, 9-11, 20, 21, 23-25, and 31-36 are pending in this application. This Amendment will cancel claims 9, 11, 23, 25, 33, and 34. Applicants expressly reserve the right to pursue protection of any or all canceled subject matter in another application. In the specification, the FIG. 2 legend is amended to correct formalities and include applicable sequence identifiers for nucleic acid and amino acid sequences shown in FIGs. 2A, 2B, and 2C. No new matter is introduced by any of the foregoing amendments.

Entry of the amendments after final action is appropriate because the amendments are believed to place the claims in a condition for allowance. Moreover, entry of the amendments would reduce the number of claims, remove the canceled subject matter from consideration and, thereby, simplify issues for appeal.

Upon entry of the foregoing claim amendments, **claims 6, 7, 10, 20, 21, 24, 31, 32, 35 and 36 will be pending in this application.** Consideration of the amendments to the specification and claims herein is requested.

Claim Objections:

An objection has been raised under 37 C.F.R. 1.75(c) against claims 9 and 23 for allegedly “being of improper dependent form.” Claims 9 and 23 will be canceled upon entry of this Amendment; hence, this objection will be moot and Applicants respectfully request that it be withdrawn.

Claim Rejections under 35 U.S.C. §112, second paragraph:

Claims 6 and 20 (and their corresponding dependent claims) have been rejected under 35 U.S.C. §112, second paragraph because allegedly “[i]t is not clear [whether] the isolated nucleic acid is the molecule encoding [the] WW or PPIase domain of Pin1 or the molecule encoding the entire Pin1 protein.” Applicants traverse this rejection at least because the claim language (prior to entry of this Amendment) clearly recites a nucleic acid molecule encoding “a WW domain of a Pin1 polypeptide” Moreover, “[s]ome latitude in the manner of

expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire” (MPEP 2173.02).

Nevertheless, to facilitate prosecution of the application, claims 6 and 20 (and, therefore, their corresponding dependent claims) will be amended upon entry of this Amendment to clearly state that the claimed nucleic acid molecule encodes “an amino acid sequence consisting of [the relevant] amino acids. . . of SEQ ID NO:2.” Thus, the claim no longer refers to a “WW domain” or “Pin1 polypeptide,” which removes the sources of the alleged confusion. If the Examiner prefers other claim language, Applicants would be willing to consider suggestions and ask the Examiner to call Applicants’ undersigned representative to discuss such suggestions.

In view of the foregoing claim amendments, Applicants respectfully request that this rejection be withdrawn.

Claims 11 and 25 have been rejected under 35 U.S.C. §112, 2nd paragraph because, allegedly, the phrase “selectively hybridize” is “vague and indefinite.” Applicants traverse this rejection. Nevertheless, merely to facilitate prosecution of this application, claims 11 and 25 will be canceled upon entry of this Amendment; hence, this rejection will be moot and Applicants respectfully request that it be withdrawn.

Claim Rejections under 35 U.S.C. §112, first paragraph:

Claims 6, 7, 9-11, 20, 21, 23-25 and 33-36 have been rejected under 35 U.S.C. §112, first paragraph (written description) because, allegedly, the “claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) . . . had possession of the claimed invention.” In particular, the Office interprets the claims as including genera of nucleotides that “(A) . . . compris[e] 13-129 or 175-489 of SEQ ID NO: 1 . . . (claims 9, 23)[;] (B) . . . can be selectively hybridized to 13-129 or 175-489 of SEQ ID NO: 1[; and] (C) . . . encode a fragment [of] SEQ ID NO: 2 comprising . . . WW domain of amino acid 5-43, PPIase domain of amino acid 59-163, or functional fragment thereof” (emphasis omitted). The Office takes the position that the specification does not

adequately describe “the full breadth of the claim[s]” in the foregoing genera. Applicants traverse this rejection.

With regard to genus (A) identified by the Office, claims 9 and 23 will be canceled by this Amendment; thus, this basis for rejection will be rendered moot. Similarly, with regard to genus (B), claims 11 and 25 are the only claims to recite “selectively hybridize[] to.” Claims 11 and 25 will be canceled by this Amendment; thus, this basis for rejection also will be rendered moot.

With regard to genus (C), none of the disputed claims as amended herein recite “comprising” language. In fact, claims 6, 7, 20 and 21 recite nucleic acid molecules encoding polypeptides that the Office has already found to be patentable in related application no. 10/648,631. Claims 10 and 24 recite subject matter that Office expressly states satisfies the written description requirement (see bottom of page 6 of the Office action). Finally, claims 35 and 36 depend from one or more of the foregoing claims and, therefore, satisfy the written description requirement for the same reasons described for the base claim(s) from which they depend.

In view of the foregoing claim amendments and arguments, Applicants respectfully request that this rejection be withdrawn.

Claim 36 has been rejected under 35 U.S.C. §112, first paragraph (enablement) because, allegedly, “the specification . . . does not reasonably provide enablement for a host cell in vivo.”

Applicants traverse this rejection at least because all of the support the Office provides for its rejection is directed to the alleged lack of enablement for “gene therapy.” Gene therapy is generally accepted by those of ordinary skill in the art to be a *method* to replace or repair targeted genes in a subject usually in the treatment of a disease or disorder (see, e.g., multiple substantially similar definitions obtained using the “define” function of Google). Claim 36 does not recite a method at all and, therefore, cannot be equated to gene therapy. Accordingly, the Office has not properly supported its enablement rejection of claim 36.

Nevertheless, Applicants believe the Office's present policy is that a claim reciting "a host cell" reads on a human organism, which human organism presently is considered by the Office to be non-patentable subject matter. Accordingly (as suggested by the Office, but not for the reasons implied by the Office), Applicants have amended claim 36 to recite, in relevant part, "[a]n isolated host cell." Applicants respectfully request that this rejection be withdrawn.

Obviousness-type Double Patenting

Claims 31, 32, 35, and 36 have been rejected under the doctrine of obviousness-type double patenting in view of claims 1-4 of U.S. Patent No. 5,972,697. Without conceding the validity of this rejection, filed herewith is a "Terminal Disclaimer to Obviate a Double Patenting Rejection over a Prior Patent" ("Terminal Disclaimer"), where the prior patent is U.S. Patent No. 5,972,697. In view of the filing of the Terminal Disclaimer, Applicants respectfully request withdrawal of the obviousness-type double-patenting rejection of claims 31, 32, 35, and 35.


CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If it may further issuance of these claims, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

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